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In re Application of
SODROSKI et al.
U.S. Application No. 09/446,820
PCT No.: PCT/US98/24001
Int. Filing Date: 10 November 1998
Priority Date: 30 November 1997
Attorney Docket No.: 157/48436
For: STABILIZED PRIMATE LENTIVIRUS
ENVELOPE GLYCOPROTEINS

DECISION ON PETITION
UNDER 37 CFR 1.47(a)

This is a decision on applicants' "Petition Under 37 CFR 1.47(a)" filed 29 September 2000 to accept the application without the signatures of joint inventor, Peter D. Kwong and Wayne A. Hendrickson. The required petition fee of \$130.00 (37 CFR 1.17(i)) has been submitted.

BACKGROUND

On 10 November 1998, applicant filed international application PCT/US98/24001 which claimed a priority date of 30 November 1997. A Demand for international preliminary examination was not filed prior to the expiration of nineteen months from the priority date. Accordingly, the twenty-month period for paying the basic national fee in the United States at midnight on 10 July 1999.

On 22 December 1999, applicant filed a transmittal for entry into the national stage in the United States, which accompanied by, inter alia: the requisite basic national fee as required by 35 U.S.C. 371(c)(1); the international application; a preliminary amendment; and a petition to revive. On 24 March 2000, the petition to revive was granted.

On 30 March 2000, the United States Designated/Elected Office mailed a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) must be filed. The notification set a one-month time limit in which to respond.

On 29 September 2000, applicant filed the present petition accompanied by Declarations executed by all of the inventors, except Peter D. Kwong and Wayne A. Hendrickson.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and behalf of the non-signing joint

inventor. Items (1), (3) and (4) have been satisfied.

Regarding item (2) above, Section 409.03(d) of the Manual of Patent Examining Procedure (M.P.E.P.), **Proof of Unavailability or Refusal**, states, in part:

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of its refusal must be specified in an affidavit or declaration by the person to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Before a refusal can be alleged, it must be demonstrated that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature. A copy of the application paper should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.

When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the affidavit or declaration. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the affidavit or declaration.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which the conclusion is based should be stated in an affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration.

A review of the present petition and the accompanying papers reveal that applicant has not satisfied item (2) above, in that the applicants have not shown that a bona fide attempt was made to present the application papers, including the specification, claims, and drawings to Peter D. Kwong and Wayne A. Hendrickson. Nicole L.M. Valtz states, "on or about January 10, 2000 . . . and August 28, 2000, I prepared and my secretary, Maria R. Valinch, sent a letter to said Ofra Weinberger via certified mail requesting execution of the previously sent Declaration and Power of Attorney, Small Entity and Assignment documents . . ." The mailing of the Declaration/Power of Attorney, Small Entity, and Assignment is not considered a complete copy of the application papers (specification, including claims, drawings, and oath or declaration). Moreover, it does not appear that the application papers were sent to the proper person. Pursuant to MPEP 409.03(d), the complete application should be mailed to the last known address of the non-signing inventor or if the nonsigning inventor is represented by counsel, to the address of the non-signing inventor's attorney. Dr. Ofra Weinberger does not appear to be the non-signing inventors counsel and the application does not appear to have been mailed to the non-signing inventors last known address.

Ms. Grodin's affidavit states that she was informed by Dr. Weinberger that the inventors are refusing to sign. However, as Dr. Weinberger does not appear to be the attorney for the inventors, any such statement would not constitute a refusal by the inventors. Further, it is not clear how Ms. Grodin "was advised by Dr. Weinberger" as to the refusal (e.g., was Dr. Weinberger's statement made directly to

Ms. Grodin?).

Mr. Sodroski's affidavit has been considered and does not appear to add any additional facts relevant to item (2).

CONCLUSION

The petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

Deposit Account No.50-0850 has been charged a \$130.00 surcharge fee under 37 CFR 492(e) for supplying an oath or declaration later than 30 months from the earliest claimed priority date, as authorized.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTH** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required.

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention to the PCT Legal Office.



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